

REMARKS

Applicant has received the Decision on Appeal dated August 28, 2009 (hereafter Decision). Claims 1-3, 5-14 and 19-25 were identified as patentable subject matter prior to the appeal, and thus the Decision does not speak to those claims. The rejection of claims 15-18 was affirmed in the Decision.

In particular, in the Appeal Brief Applicant argued that server 120 and smart storage units 114 of Mikesell's file system 110 could not be combined to anticipate the claimed server. However, in the Decision the following statement is made, "Claim 15 recites, *inter alia*, that the first and second storage devices are *coupled to* the server, and does not require that the storage devices be separate/distinct units from the server."¹ With this Preliminary Amendment, Applicant amends claim 15 to expressly state that the claimed storage devices are not only distinct from the server, but also distinct from each other. Based on this amendment and the logic of the Decision, Applicants respectfully submit that Mikesell cannot now anticipate the limitations of claim 15, and thus claim 15 should be allowed.

Mikesell's server 120 cannot be the claimed server, as Mikesell's server 120 does not make a "selection of the storage location ... based on the attributes of the storage devices and storage preferences for the file." Mikesell's switch 125 selects the storage unit 114, and the then the storage unit 114 selects which of the storage units 114 across which to strip the data. Neither the operation of the switch 125 or the storage unit 114 appear to be "based on ... storage preferences for the file." Likewise, Mikesell's storage units 114 cannot be the claimed server, as Mikesell's storage units 114 do not "accept files in a user namespace and in a user file structure; and ... [store] the file on at least one of the first and second storage devices in a global namespace different than the user namespace." Per the Decision, it is the server 120 of Mikesell that performs the translation.

¹ Decision on Appeal of August 28, 2009, Page 6, first full paragraph (emphasis original).

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Lest the next Office action merely make the rejections of claim 15-18 into a Section 103 rejection over Mikesell, modifying Mikesell to meet the claim limitations is improper in this circumstance. In particular, the Manual of Patent Examining Procedures (MPEP) admonishes:

**THE PROPOSED MODIFICATION CANNOT CHANGE THE
PRINCIPLE OF OPERATION OF A REFERENCE**

If the proposed modification ... of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.²

The clear principle of operation of Mikesell is for each smart storage unit 114 to have the ability to read and write stripped files across all the smart storage units 114. To modify Mikesell such that only one smart storage unit 114, or alternatively the server 120, has the ability to selection storage locations and to save files, changes the clear principle of operation of Mikesell, and is thus improper. Particularly since it appears to be the switch 125 which selects the smart storage unit 114 to which to send each request.³

CONCLUSION

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including

² MPEP 8th Ed., Rev. 3, August 2005, Section 2143.01(VI), p 2100-138.

³ Mikesell Paragraph [0062], lines 10-13.

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fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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